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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,605	08/30/2000	Gilma A. Z. Perkins	MSFT-0166/144193.1	9087
41505	7590	09/27/2006	EXAMINER	
WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION) ONE LIBERTY PLACE - 46TH FLOOR PHILADELPHIA, PA 19103			ALVAREZ, RAQUEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/650,605

Applicant(s)

PERKINS ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 7/21/2006.
2. Claims 1-10 and 20-27 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-10 and 20-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The business directory listings being child nodes of the leaf nodes and the business category nodes being parent nodes of the leaf nodes. The specification doesn't describe how the leaf node level maps only to the business directory listing.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. With respect to claims 1 and 6, it is confusing how the leaf node can only map to the business listing nodes, when the claims also recite a relationship of the leaf nodes to the business directory listing and the business category nodes. If they are relationship between all the elements then elements should a function of each other.

For purpose of examination, it will be treated as not being exclusive only to the business directory node.

Correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10 and 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yacoby et al. (6,516,311 hereinafter Jacoby).

With respect to claims 1-10, 20 Yacoby teaches a computer-implemented method to register business directory listing and advertisements (Abstract). Providing a computer-based directory of business listings and advertisements, said directory being stored in a data store and comprising data organized as a tree having nodes, wherein a plurality of nodes are representative of business categories, and plurality of said nodes are leaf level nodes, and a plurality of said nodes are business directory listings having standard industry codes associated therewith, wherein only said leaf nodes map to said business directory listing nodes (col. 9, lines 13-25); accepting, from a client, via a network, at least one request to register a desired business listing and/or

advertisement, said request indicating at least one of said business categories and association with said desired business listing (col. 13, lines 11-24);

Storing said desired business listing and/or advertisement in said directory according to said at least one of said business categories (see col. 15, lines 1-41); the registration may be performed specifying at least editorial nodes (col. 14, lines 38-41); a user interface to accept instructions for the manipulation and display of data via the Internet (col. 12, lines 25-51).

With respect to the business directory listing being child nodes of the leaf nodes and the business category nodes being parent nodes of the least leaf nodes it would have been obvious to have included in the Yacoby's reference for directory listings to have parent and child relationships because such a modification would allow for relevancy between the nodes.

Claims 21, 25 and 27 further recite well known information necessary to advertise a product or service. Since Yacoby teaches advertising a product or service then it would have been obvious to obtain certain information such as the description desired, the number of lines desired, the text to be printed, the color desired and image and titles in order to customize the individual ads. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the above steps in the advertisements of Yacoby in order to obtain the above mentioned advantage.

With respect to claim 22, Yacoby further teaches prompting the user to enter e-mail address (col. 12, lines 26-39).

With respect to claims 23-24, Yacoby further teaches a hyperlink to the user's content and prompting the user to input an URL for the website (col. 13, lines 1-10).

Claim 26 further recites displaying the ads according to a particular rotation scope which defines a display frequency of one or more geographic areas. Official notice is taken that it is old and well known in marketing to define take into account the geographic region in order to determine how often to advertise in a particular region in order to better target the ads based on the geographic areas selected. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included displaying the ads according to a particular rotation scope which defines a display frequency of one or more geographic areas in order to obtain the above mentioned advantage.

Response to Arguments

7. Applicant argues that in Yacoby that the elements of Yacoby, business category/industrial code, business subcategory, location and sublocation are not related in a tree as parent and child relationships. The Examiner wants to point out that the claims were rejected under 103 and therefore the arguments are not relevant. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Applicant argues that the elements of Yacoby, business category/industrial code, business subcategory, location and sublocation are not related in a tree as parent and child relationships. The Examiner wants to point out that the claims were rejected under 103 and therefore the arguments are not relevant. The Examiner had pointed out in the rejection that it would have been obvious to have a relationship between the elements in order to show relevancy between the elements. In addition, since Yacoby teaches on col. 9, lines 13-25, **category and subcategory; location and sublocation** then chances are that there is a relationship between the elements and the subelements.

8. Applicant states that Yacoby implies that the business category/industrial code is the highest level and that in the instant application, the business category is the lowest level of organization. The Examiner wants to point out that the claims recite "the business directory listing being child nodes of the leaf nodes and the business category nodes being parent nodes of the least leaf nodes" Therefore, according to the recited claims, the business category nodes is the parent node, which is the highest level, followed by the leaf nodes and the business directory. The Examiner doesn't see where Applicant is claiming that the business category is the lowest of the organization. According to the recited claims the business category is the parent of the leaf node and therefore the highest level of the organization.

9. Applicant argues that the present invention do not include a telephone number as required by Yacoby. Applicant is reminded that the reference cited can contain

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additional teachings, but what is important is that the reference cited teaches at least the features that are claimed.

10. With respect to a leaf node level that maps only to business directory listings. The Examiner wants to point out the 112, 2nd rejection above and the Examiner is treating this limitation not exclusive to the leaf node and the business directory listing.

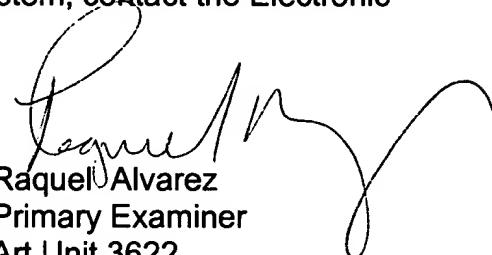
11. In response to applicant's arguments that Jacoby doesn't teach storing the desired business listing and/or advertisement in the directory, the Examiner wants to point out that Jacoby teaches on col. 15, lines 1-41, storing the business listing, e.g. "O'Melveney & Meyers" along with the subcategory field-intellectual property and in the category field-attorney and in the location field-Los Angeles.

Point of contact

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
2/8/2006